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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,008	02/23/2004	John P. Hely	12,574	7471

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EXAMINER

LEWIS, KIM M

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,008

Applicant(s)

HELY ET AL.

Examiner

Kim M. Lewis

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-19 and 21 is/are allowed.
- 6) ☒ Claim(s) 1,3-13,15 and 20 is/are rejected.
- 7) ☒ Claim(s) 2 and 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/23/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 2/23/04 has been received and made of record. Note the acknowledged form PTO-1449 enclosed herewith.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: '58" and "97".
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "90" has been used to designate both the thumb and the holder material.
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3743

Specification

5. The disclosure is objected to because of the following informalities:

Page 11, lines 10-13 are confusing in that it is unclear to the examiner if "98" or "97" is the strap.

Appropriate correction is required.

Claim Informalities

6. While the metes and bounds of claims 1, 19 and 21 are definite, the following informalities are deserving of correction:

Claim 1, lines 11, after "straps" insert --there through--;

Claim 19, line 1, "whereas" should read --wherein--; and

Claim 21, item iii should be written as an action limitation, for example, --wrapping the retention strap...--.

Claim Objections

7. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. More specifically, the subject of claim 3 is presently recited in claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards claim 6, the recitation of "a flap" is confusing. Is it an additional flap? If so, rename it such as, for example, third flap. Is it the same flap as one of the previously recited flaps? Also, "all three straps" lacks proper antecedent basis.

As regards claim 9, the claim as written is confusing.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3-7 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,307,521 ("Davis").

As regards claim 1, Davis discloses a protective device for a body part, which is capable of use on the wrist. The device of Davis includes ribs (30, 32), which brace the body part and can therefore be considered a brace. As to the structural limitations present in the body of the claim, the protective device of Davis comprises combination a

Art Unit: 3743

flexible holder (10) adapted to receive the a) user's wrist and having two flaps (wings 18) adapted to be closed toward one another or toward the wrist to secure the holder about the wrist of the user, b) a carrier (40) associated with one flap; tightening straps (38) associated with said carrier, said straps having ends anchored by said carrier, d) loops (36) on the other flap to pass said straps, e) the straps and carrier having connective material thereon whereby the straps can be pulled and tightened after passing through said loops, to adjustably press-together on the connective material on the carrier (col. 4, lines 3-13).

As regards claim 3-6, note Fig. 1 of Davis, which discloses that the strap ends are anchored by said carrier, that the anchored ends of the said straps are attached to said carrier at locations spaced along the length of said carrier, and that the loops are in lengthwise alignment.

Regarding claim 7, as can be seen from Fig. 1, Davis discloses at least two stiffeners (ribs 30, 32) carried by the holder, and extending lengthwise thereof, said stiffeners spaced apart about a wrist reception zone, whereby flexible holder zones are defined between or proximate to the stiffeners. The applicant should note the since the device of Davis is pliable, thereby being flexible, it has pliable (flexible) zones extending between its ribs.

As regards claim 13, the device (holder) of Davis has a u-shaped cross section when the device is wrapped around a user (Fig. 3).

Art Unit: 3743

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis.

As regards claim 6, Davis discloses at least one stiffener in the form of a rib carried on a layer of the holder. Davis fails to teach that the at least one rib is carried by a flap.

The examiner contends that although layer of the device (holder) is not a flap it functions to carry the rib and therefore as claimed is an equivalent structure, which performs the same function as the presently claimed flap.

As such, it would have been obvious to one having ordinary skill in the art to substitute one layer of the device (holder) for a flap as an obvious substitution of an equivalent part.

As regards claim 8, Davis discloses stiffeners in the form of ribs, but fails to teach the ribs are constructed from metallic material. However, the examiner contends that metallic stiffeners are well known in the art and that it would have been *prima facie* obvious to one having ordinary skill in the art to used metallic stiffeners or ribs depending upon the amount of rigidity is desired in the stiffeners.

Also, the applicant should note that it has been held that the selection of a known material based upon its suitability for the intended used is design consideration within the skill of the art. In re Leshin, 227 F. 2d 197, 125 USPQ 416 (CCPA 1960).

16. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of U.S. Patent No. 5,415,624 ("Williams").

As regards claims 9-12, Davis fails to teach cushioning material underlying the ribs (stiffeners), a flexible auxiliary strap connected to the holder to be adjustably folded

Art Unit: 3743

over a zone between the user's thumb and forefinger, for adjustable connection to the holder, for firmly attaching the holder in lengthwise position on the wrist, that the auxiliary strap also carries connective material which press attaches to said connective material on the holder, and that there are three of said tightening straps positioned in spaced relation to the auxiliary strap, when said auxiliary strap is adjustably connected to said connective material on the holder.

Williams, however, discloses a wrist brace comprising cushioning material underlying a stiffener, a flexible auxiliary strap connected to the holder to be adjustably folded over a zone between the user's thumb and forefinger, for adjustable connection to the holder, for firmly attaching the holder in lengthwise position on the wrist, that the auxiliary strap also carries connective material which press attaches to said connective material on the holder, and that there are three of said tightening straps positioned in spaced relation to the auxiliary strap, when said auxiliary strap is adjustably connected to said connective material on the holder for the purposes of cushioning the user's body part against the stiffener and for maintaining the brace in position on the user's hand and wrist, respectively.

In view of Williams, it would have been obvious to one having ordinary skill in the art to provide the device of Davis with cushioning material underlying a stiffener, a flexible auxiliary strap connected to the holder to be adjustably folded over a zone between the user's thumb and forefinger, for adjustable connection to the holder, for firmly attaching the holder in lengthwise position on the wrist, that the auxiliary strap

Art Unit: 3743

also carries connective material which press attaches to said connective material on the holder, and that there are three of said tightening straps positioned in spaced relation to the auxiliary strap, when said auxiliary strap is adjustably connected to said connective material on the holder for the purposes of cushioning the user's body part against the stiffener and for maintaining the brace in position on the user's hand and wrist, respectively.

As regards claim 15, the places that hold the ribs of the device of Davis are considered pockets. Davis, however, fails to teach the ribs are bowed. Williams, however, discloses a wrist brace having a bowed stiffener in order to hold the wrist in a certain position.

In view of Williams, it would have been obvious to one having ordinary skill in the art to provide the device of Davis with bowed ribs in order to hold the body part of the user in a desired position.

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of U.S. Patent No. 6,024,715 ("Maxwell").

As regards claim 20, Davis fails to teach a stretchable protective web interconnecting free end portions of the flaps. Maxwell, however, teaches it is conventional in the art to provide wrist braces with teach a stretchable protective web (36) interconnecting free end portions of the flaps in order to allow for one-handed application of the device on the user (col. 3, lines 23-29).

Art Unit: 3743

In view of Maxwell, it would have been obvious to one having ordinary skill in the art to provide the device of Davis with a stretchable protective web (36) interconnecting the free end portions of the flap (18) in order to allow for one-handed application of the device on the user.

Allowable Subject Matter

18. Claims 16-21 are allowed.

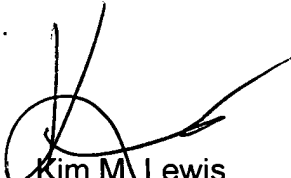
19. Claims 2 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kim M. Lewis
Primary Examiner
Art Unit 3743

kml
January 8, 2005